

Remarks/Arguments

The specification has been amended to update the status of the priority applications, and to address various informalities raised in the Office Action.

Prior to the present amendments, Claims 49-59 were pending in this application. Claims 49-54 and 56-59 were rejected, claim 55 was objected to. Claims 49-53 and 56 have been canceled and claim 54 has been amended by the foregoing amendment. All cancellations and amendments were made without prejudice, specifically reserving Applicants' right to pursue any deleted subject matter in one or more continuing applications.

All amendments to the specification and claims are of formal nature and do not add new matter.

Change of correspondence address

A new Power of Attorney was filed in this case on March 30, 2005, and a Notice of Acceptance mailed on April 25, 2005. Accordingly, Applicants respectfully request the Examiner to note the new address:

Ginger R. Dreger
Heller Ehrman, LLP
275 Middlefield Road,
Menlo Park, CA 94025

Applicants request all future correspondence in this case to be sent to the above mentioned address.

Priority

According to the Office Action, the claims pending in this application are entitled only to the priorities of PCT/US98/24855 filed 11/20/98, US application 09/254,465 filed 3/5/99 and US application 09/953,499 filed 9/14/01. The Examiner, while acknowledging that PCT/US98/19437 filed 9/17/98 also disclosed the amino acid sequence of PRO245 and the encoding nucleotide sequence, holds that "only the three priority applications listed above disclose an enabled use for PRO245, namely, that it inhibits VEGF stimulated proliferation of endothelial cells or induces apoptosis in endothelial cells." Although in this section, the

Examiner fails to explain why the present application would not be accorded to the 9/17/98 priority of PCT/US98/19437, which discloses that PRO245 tested positive in the mixed lymphocyte reaction (MLR) assay (Example 2, on page 50), according to a statement in the last paragraph on page 5 the "MLR results are contradictory and do not provide the skilled artisan with guidance for how to use the polypeptide." Presumably, this is the reason why the Examiner found that the claims are not entitled to the 9/17/98 priority of PCT/US98/19437.

Applicants respectfully disagree, and submit that the claims pending should be accorded the 9/17/98 priority of PCT/US98/19437.

At the time the present invention was made, the MLR assay was a well known and widely used proliferative assay of T cell function, the basic protocol of which is described, for example, in Current Protocols in Immunology Vol. 1, Richard Coico, Ed., JohnWiley & Sons, Inc., 1991, Unit 3.12 (incorporated by reference in the description of the MLR protocol in Example 5 of the present application). The MLR assay measures the ability of a test substance to induce the proliferation of T cells that have been activated, or co-stimulated, by dendritic cells, and thus identifies immune stimulants that can boost the immune response of a patent in need. Such immune stimulants find important clinical applications, such as, for example, in the field of cancer immunotherapy and cancer vaccines. There is nothing contradictory about the data presented in Example 5 of the present application and Example 2 of PCT/US98/19437.. On the contrary, based on these data one of ordinary skill at the time the invention was made would have well known how to use the claimed polypeptides.

Accordingly, Applicants respectfully request that 9/17/98 (PCT/US98/19437) be accorded as the earliest priority to all claims pending in this application.

Specification

Re 3. The specification on page 1 has been amended to reflect the status of parent application Nos. 09/953,499 and 09/254,465, as requested.

Re 7. The specification was objected to for allegedly failing to provide a brief description of each individual figure. The legends of Figures 1, 9 and 10 have been amended to refer to Figures 1A and 1B, Figures 9A and 9B, and Figures 10A and 10, respectively. It was not

necessary to amend the description of the figures since the "individual panels" of Figures 1A and 1B, and 9A and 9B show the same sequences, which did not fit one page, and the legend to Figures 10A and 10B already contained a separate description for the two panels.

Re 10. Applicants were requested to supplement the deposit statement on page 68 by adding that the deposit will be maintained for a term of at least 30 years and at least five (5) years after the most recent request for the furnishing of a sample of the deposit was received by the depository. The foregoing amendment in the specification complies with this requirement.

Information Disclosure Statement

Re 4. The Examiner had objected to items 15-17 of the previously submitted IDS because these entries did not comply with the requirements of 37 C.F.R. § 1.98(a)(2). Applicants submit that the individual sequence references of the BLAST results provided in items 15-17 were already itemized, providing the accession number, database, author, date of submission or publication, in the IDS submitted June 2, 2004. The Blast results in items 15-17 were merely provided for the Examiner's reference. Accordingly, the Sequence Listing of record, which has been considered by the Examiner, is believed to be both accurate and complete.

Sequence Listing and Figures

Re 6. The Examiner found a discrepancy between the sequence set forth in Figure 5 and SEQ ID NO: 11. It has been found that, due to an inadvertent and obvious mistake, SEQ ID NO: 11 is a duplicate of SEQ ID NO: 7, and does not correspond to the sequence of Figure 5. The attached substitute Sequence Listing corrects this mistake. While preparing the corrected Sequence Listing, Applicants have additionally found that Figure 5, as filed with the present application, lacks certain N-terminal nucleotides, which have been covered by the designation "SEQ ID NO: 11." Accordingly, a new Figure 5 is also submitted with the present Amendment and Response, which corrects this error. Since the entire nucleotide sequence of Figure 5 was properly shown in Figure 5 of provisional application 60/109,304, the entire disclosure of which has been incorporated by reference into the present application, the present submission of the correct complete sequence does not constitute new matter.

Claim Rejections – 35 U.S.C. § 112, first paragraph-new matter

Re 9. Claims 49 and 53 were rejected under 35 USC 112, first paragraph for their recitations of "having at least 80%/99% amino acid sequence identity." The Examiner noted that the specification does not provide clear support for these limitations.

Claims 49 and 53 have been canceled, without prejudice and without acquiescing to the Examiner's position, which moots the present rejection.

Claim Rejections – 35 U.S.C. § 112, first paragraph-enablement

Re 10. Claims 49(c)-54(c) and 57-59 were rejected under 35 USC 112, first paragraph for alleged lack of enablement. The Examiner noted that the deposit statement, as provided on page 68 of the specification, was incomplete, since it did not confirm that the deposit will be maintained at least five (5) years after the most recent request for furnishing of a sample of the deposit was received by the depository. The foregoing amendment to the specification adds this statement, which is believed to overcome the present rejection.

Re 11. Claims 49-54, 56 and 58-59 were further rejected under 35 USC 112, first paragraph. According to the rejection, the specification is enabling for an isolated polypeptide comprising SEQ ID NO: 9 or an isolated polypeptide molecule having 80% amino acid sequence identity to the amino acid sequence of SEQ ID NO: 9 for the inhibition of VEGF stimulated proliferation of endothelial cells, it does not reasonably provide enablement for the rest of the claims.

Claims 49-53 and 56 have been canceled. Without acquiescing to the rejection, the remaining claims are now drawn to subject matter which has been acknowledged to be enabled, including original parts (c) of the claims (now parts (b)), which were rejected only due to an incomplete deposit statement, which has been supplemented by the foregoing amendment. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the present rejection.

Claim Rejections - 35 USC § 112, first paragraph -written description

Re 12. Claims 49-54, 56 and 58-59 were rejected as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The cancellation of claims 49-52 and 56 moots their rejection. The rejection of the remaining claims is respectfully traversed.

Without acquiescing to the present rejection, or any reasoning advanced in support of the present rejection, the claims are now directed to polypeptides comprising sequences which are specifically disclosed in the specification or are deposited under the terms of the Budapest Treaty. There is no doubt that one of ordinary skill would recognize that Applicants were in the possession of this subject matter at the time the present invention was made. Indeed, the Examiner acknowledged that the specification provides adequate written description for polypeptides comprising SEQ ID NO: 9, while the deposit provides written description for the claims or parts of claims that recite an ATCC deposit number (claims 54 and 57). Therefore, the Examiner is respectfully requested to withdraw the present rejection.

Claim Rejections -35 USC § 102

Re 15 and 16. Claims 49-51 were rejected under 35 USC 102(a) as allegedly being anticipated by WO 98/40483 (9/17/1998). Claims 49-51 were additionally rejected under 35 USC 102(e) over US 6,448,230. According to the rejections, the cited references disclose a polypeptide which has 91% amino acid sequence identity to the amino acid sequence of the polypeptide of SEQ ID NO: 9.

Without acquiescing to the present rejection, the cancellation of claims 49-51 moots their rejection.

Applicants note that claim 55 was indicated as being allowable if rewritten in independent form, including all limitations of the base claim and intervening claims. Since claim

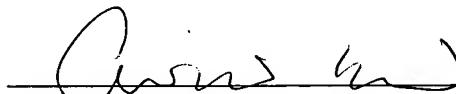
54, from which claim 55 depends, is believed to be allowable, claim 55 has been retained in a dependent form.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-1216R1C1D5). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: July 11, 2005


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